

### **REMARKS**

#### **Group Election**

According to the Office Action, the application contains three distinct embodiments of the claimed of invention comprising the following:

- I. Claims 1-11, drawn to a camshaft assembly, classified in class 74, subclass 595.
- II. Claims 12-25, drawn to a method of producing a camshaft, classified in class 29, subclass 8881.1.
- III. Claims 26-36, drawn to an apparatus for producing lateral indentations in a camshaft, classified in class 29, subclass 6.01

In response, Applicants elects Group II, and specifically the species illustrated in Figure 3 and corresponding to claims 12-24 for prosecution with *traverse*. It should be recognized that the claim 12 is generic and reads on all the embodiments depicted in Figures 2-6. Furthermore, the camshaft 11 illustrated in Figures 1-6 may be formed by any of the embodiments illustrated in Figures 2-6. Therefore, Claims 1-11 should properly be reviewed alongside claims 12-24 as elected.

The Applicants note that the Examiner recognizes that Inventions I and II are related as process of making and product made. In addition, however, the Examiner asserts that the inventions are distinct in that either (1) the process claimed can be used to make a materially different product or (2) the product claimed can be made by a materially different process. The Applicants traverse this assertion and seeks reconsideration.

#### **Process to make a materially different product.**

The method of claims 12-25 claims a method for making a camshaft. The Examiner's assertion that it could be utilized to make a materially different product such as a pipe coupling is inaccurate. The limitations of the method claim specifically require securing CAMS onto a tubular SHAFT. There is only a single product that results from cams mounted on a shaft – namely a camshaft as is claimed in claims 1-11. Furthermore, the method of claim 12 specifically recites the limitation of hot-forming a lateral indentation on the shaft between two cams. Thus the method of claim 12 cannot

be utilized to form anything other than a camshaft with hot-formed lateral indentations. Otherwise the limitations within claims 12-25 would be meaningless. Claims 1-11 specifically claims a camshaft with hot-formed lateral indentations. Clearly, Claims 12-25 cannot be utilized to form a materially different product if any of the limitations contained therein are recognized. The Applicants request reconsideration.

**Product made by a materially different process**

Conversely, Claims 1-11 cannot be made by a process materially different than that claimed in claims 12-25. The hot-formed lateral indentations as defined by the specification cannot be formed by a process different than that claimed in claims 12-25. Casting or molding do not comprise hot-formed lateral indentations as defined by the specification. In addition, casting or molding would not result in the multiple part assembly with force-locking connections between the cams and shaft as taught by the present invention. The Applicants respectfully request reconsideration.

**Species Election**

The Examiner further requires an election of patentably distinct species which were identified as follows:

- i. Figures 1a-1c
- ii. Figures 2a-2b
- iii. Figures 3a-3b
- iv. Figures 4a-4b
- v. Figures 5a-5d
- vi. Figures 6a-6b

The Applicants as stated above respectfully elects species iii with traverse. The Applicant calls the Examiner's attention to the fact that Figures 2, 3, 4 and 6a depict methods capable of producing a camshaft illustrated in Figure 1. As the elected group was claims 12-24 regarding the method of making a camshaft which includes generic claim 12 which reads on each and every species illustrated in Figures 2,3,4,5 and 6, the Applicant respectfully asserts that the Examiner has failed to establish a *prima facie*

case for restricting the claims. The Applicant calls the Examiner's attention to the application subject matter and claims wherein there is no clear indication of separate future classification and field of search. Every claim and embodiment is directed towards the identical classification and field of search. In support of this, it is noted that independent claim 12 reads on every disclosed embodiment in the present application. Therefore, not only is this a generic claim but in order to properly examine the patentability of any single embodiment, both classification, field of search, and burden on the Examiner would be identical to that involved in evaluating every other embodiment or species. The cited embodiments would provide no undue burden on the Examiner, nor would they raise any additional issues. The embodiments primarily vary only in how a bending moment is imparted into the shaft, variation on how the electrodes are represented, and whether the punches are performed simultaneously. The Applicant submits that a *prima facie* case for restricting the claims has not been properly established. No proper indication of different classification or field of search has been established. Furthermore, the nature of the embodiments clearly indicates that no undue burden would be placed on the Examiner. The Applicant, therefore, respectfully requests reconsideration of the restriction requirement.

Applicant reserves the right to add the non-elected claims upon the allowance of a generic claim containing the same general inventive concept as the non-elected claims.

The Examiner is invited to telephone the Applicants' undersigned attorney at (248) 433-7221 if any unresolved matters remain with respect to this Response.

Respectfully submitted,

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Dated: November 15, 2007  
BLOOMFIELD 38394-3 879583v1